

9/25/03
#361 elect 11mDocket No. 00054CIP**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE**

Applicant: James A. Belmont Group Art Unit: 1756
Application No.: 09/896,880 Examiner: John A. McPherson
Filed: June 29, 2001 Confirmation No.: 1018
For: **MODIFIED PIGMENT PRODUCTS, DISPERSIONS THEREOF, AND
COMPOSITIONS COMPRISING THE SAME**

Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

RESPONSE TO RESTRICTION REQUIREMENT

Sir:

In response to the Office Action mailed May 19, 2003, which sets forth a restriction requirement, Applicant elects, with traverse, the species of claims 10-18 for further prosecution along with generic claims 1-9. The species election is made for search purposes and, upon allowance of a generic claim which embraces this species, Applicant reserves the right to consideration of claims to additional species which are written in dependent form or otherwise include all the limitations of an allowed generic claim.

Applicant respectfully submits, however, that the restriction requirement is improper, in whole or in part, for the reasons set forth herein and, therefore, request withdrawal of the restriction requirement.

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The Manual of Patent Examining Procedure (M.P.E.P.) recites the requirement for a proper restriction requirement. In particular, the M.P.E.P. states:

There are two criteria for a proper restriction requirement between patentably distinct inventions:

(A) The inventions must be independent (see M.P.E.P. Section 802.01, Section 806.04, Section 808.01) or distinct as claimed (see M.P.E.P. Section 806.05 - Section 806.05(i)); *and*

(B) There must be a serious burden on the examiner if restriction is required (see M.P.E.P. Section 803.02, Section 806.04(a) - Section 806.04(i), Section 808.01(a), and Section 808.02).

(M.P.E.P. § 803 (emphasis added)). These are two separate criteria that must be satisfied to support a proper restriction requirement. The fact that *both* criteria must be satisfied is made all the more clear by the following statement in the M.P.E.P.:

If the search and examination of an entire application can be made without serious burden, the examiner *must* examine it on the merits, even though it includes claims to independent or distinct inventions.

(M.P.E.P. § 803 (emphasis added)). Thus, if the subject matter of the pending claims is such that there would be no serious burden on the examiner to search and examine all of the pending claims at the same time, the examiner is to do so, *even if* the pending claims are drawn to independent or distinct inventions.

With respect to the present application and the outstanding restriction requirement, the Examiner has identified 11 allegedly distinct species of the present invention - dispersion compositions (claims 10-18), printing plate and method (claims 19-34), thermal transfer recording material (claims 35-36), proofing material (claims 37-38), black matrix (claims 39-40), electrophoretic display (claims 41-48), inkjet ink (claims 49-51), use in a coating (claim 52), use in a polymer composition (claim 53), use in an ink (claim 54), and use in a toner composition (claim 55). However, each independent claim for the individual sets of species identified by the Examiner

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comprises the modified pigment product of generic claim 1 and are therefore not independent inventions. Furthermore, a search of this modified pigment product would necessarily also encompass specific uses of modified pigments. Therefore, Applicant believes that the claims of these 11 groups have quite similar subject matter and overlap to such an extent that there will be no serious burden on the Examiner to search and examine all of the pending claims at the same time.

In view of the foregoing remarks, Applicant respectfully requests withdrawal of the restriction requirement, such that all of the pending claims are considered together. If, in the opinion of the Examiner, a telephone conference would expedite the prosecution of the present application, the Examiner is invited to call the undersigned attorney.

Respectfully submitted,

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